

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/372,474 08/11/99 BAIRD

E 2387168

MICHAEL A. WHITTAKER  
FOLEY & LARDNER  
402 W. BROADWAY  
23RD FLOOR  
SAN DIEGO CA 92101

HM22/1023

 EXAMINER

MARSCHEL, A

ART UNIT	PAPER NUMBER
----------	--------------

1601

17

DATE MAILED:

10/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/372,474	Applicant(s) Dervan et al.
Examiner Ardin Marschel	Art Unit 1631



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Aug 14, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1835 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-48 is/are pending in the application.  is/are withdrawn from consideration.  is/are allowed.  is/are rejected.  is/are objected to.  Claims 1-48 are subject to restriction and/or election requirement.

5)  Claim(s) \_\_\_\_\_

6)  Claim(s) 1-4 and 41-48

7)  Claim(s) \_\_\_\_\_

8)  Claims 1-48

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19)  Notice of Informal Patent Application (PTO-152)

20)  Other: \_\_\_\_\_

Applicants' election with traverse of Group I with chemical specie  $\text{ImImHpPy}-\gamma\text{-ImPyPyPy}-\beta\text{-Dp}$  (claims 1-4 and 41-48) in Paper No. 5, filed 1/12/01, is acknowledged. The traversal is on the ground(s) that the examination of Groups I, II, VI, and VII can be made without serious burden on the Examiner. Applicants allege that no serious search burden has even been alleged in the restriction requirement. In response this allegation ignores the paragraph bridging pages 3 and 4 of the restriction requirement, mailed 12/13/00, where distinct subject matter documenting the serious search burden if such Groups were searched together contrary to the allegation of applicants. Applicants then argue that a search for a larger polymer will encompass the search for a smaller polymer with smaller m number. This is non-persuasive in that such a search most commonly will include a chemical structure search using computer systems and databases such as CAS supplies. Such searches are not performed by first searching for a small polymer and enlargening it for larger polymers. Each search is separately submitted and must be separately considered as to prior art potentially found therein. Thus, the arguments of applicants have not been found persuasive as indicating search strategies that are not performed and thus cannot document what search burden is present when invention Groups which are distinct are searched together.

The requirement is still deemed proper and is therefore made

FINAL.

Applicant is hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". Due to the above notification Applicant is required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

Claims 1-4 and 41-48 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the elected specie has been repeated above from applicants' election, filed 1/12/01, as the following:

ImImHpPy-γ-ImPyPyPy-β-Dp

Confusingly, comparison of this elected specie to the polyamide that is being designed as noted in claim 1 reveals that the claim 1 polyamide lacks the end groups: β-Dp. Is the elected specie incorrectly elected as not a specie within the invention of Group I or is the polyamide structure shown in claim 1, line 2, not what applicants are actually designing? Clarification of this discrepancy is requested.

Claims 41-48 are directed to polyamide compositions of claim 1 whereas confusingly claim 1 is a method for designing a polyamide which does not actually produce the polyamide. Clarification of whether claims 41-48 are directed to virtual designs of actual compositions is requested via clearer claim wording.

Abbreviations in claims cause them to be vague and indefinite unless they are accompanied by a full name of the entity. It is noted that such abbreviations are present in the instant claims given as "Im", "Hp", "Py", " $\beta$ ", "A", "G", "C", and "T". Clarification via full names are requested in the claims.

Claim 4 indicates a sequence specificity greater or equal to ten. Clarification as to what is meant by specificity of ten is requested via clearer claim wording.

In claim 41 the structural formula contains the parameter "n" but nowhere in the claim are the metes and bounds of this parameter defined. Clarification is requested via clearer claim wording.

The disclosure is objected to because of the following informalities:

Periods within claims may only be present at the end and at abbreviations. In claim 1 the periods after the parts such as in "a.", "b.", etc. should be replaced with brackets such as "a)", "b)", etc. to remove these informalities.

In claim 1, line 4, the word "aminobuytic" appears to be misspelled.

In claim 47, line 1, the word "conprising" appears to be misspelled.

Correction is required.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

October 19, 2001

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER